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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,965	12/04/2001	Alain Calvet	5808-01-CA	3513

7590

01/22/2003

Charles W Ashbrook
Warner Lambert Company
2800 Plymouth Road
Ann Arbor, MI 48105

EXAMINER

DESAI, RITA J

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,965

Applicant(s)

CALVET ET AL.

Examiner

RITA J. DESAI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____

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DETAILED ACTION

Claims 1-12 were pending since the restriction in paper # 5 was drawn to a method of treating.

Applicants have canceled claim 10 .

Hence claims pending are 1-9,11,12.

Response to Arguments

Applicants have canceled all the compound claims and amended them to a method of treating various types of pains especially neuropathy pain.

The claims 3-5, 9-13 objection has been withdrawn since applicants have amended the claims.

The rejection of claim 4 under 35 USC 112 has also been withdrawn since applicants have amended the claims to define the R1 and r5 clearly.

The rejection of claims 1-3,5-8 under 35 USC 102 over Claremon US 5439914, Gilligan et al, Wilma Quaglia et al have all been withdrawn since applicants have amended the claims to just the method of treating.

The rejection of claims 1-13 under 35 USC 103 over Gilligan et al and Journal of Clinical Anesthesia Laszlo Gyermek still stands.

Gilligan et al discloses the compounds of the invention when its R2 is an alkyl group substituted by a phenyl. The reference clearly teaches that the tetralins are ligands for serotonin receptors. See page 365 after the fig. 14.

Laszlo Gyermek clearly teaches that serotonin is widely distributed in the body within the central and peripheral nervous systems. It also teaches that serotonin inhibitors can also treat pain syndromes. (See page 402 of the reference) Thus one of skill in the art would have found it obvious use the compounds that have serotonin activity to treat pain , especially ones that

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were associated with the nervous system, such as neuropathy , trigeminal neuropathy, migraine and such.

See Serotonin 5HT..... Peter Goadsby. The reference teaches the relationship between migraine and peripheral trigeminal nerve activation. See abstract and whole document.

Thus rejection still stands on the pending claims 1-9,11,12.

Conclusion

The rejection of claims 1-9,11-12 still stands. Examiner is not making the action Final since she has added a new reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RITA J. DESAI whose telephone number is 703-305-1868. The examiner can normally be reached on Monday - Friday, 9:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


R.D.

January 16, 2003